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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,407	10/20/2003	Sam Johnson	01003.1010	2572

35856 7590 07/29/2005

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EXAMINER

COBURN, CORBETT B

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 07/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

7/2/05

Office Action Summary	Application No.	Applicant(s)	
	10/689,407	JOHNSON, SAM	
	Examiner	Art Unit	
	Corbett B. Coburn	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 11-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12 Apr 05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The use of the trademark Odyssey has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner that might adversely affect their validity as trademarks.

2. Paragraph 0002, line 1, "along" should be "a long". Appropriate correction is required.
3. Paragraph 0004 states that filtering "advantageously results in filtering out valuable information that could be used by the operators of the games." Surely, this is a disadvantage...
4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Objections

5. Claim 1 is objected to because of the following informalities: Subject/verb agreement. "Criteria" is plural and should take a plural verb. Appropriate correction is required.

Election/Restrictions

6. Applicant's election of claims 1-10 in the reply filed on 18 July 2005 is acknowledged. Applicant has presented Examiner with something of a dilemma. Applicant has traversed the

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restriction, but has also submitted an amendment withdrawing all of the non-elected claims.

Withdrawing the claims is tantamount to an election without traverse. Given that the claims have been withdrawn (and therefore cannot be examined), Examiner believes the amendment takes precedent over Applicant's traversal. Therefore, the election/restriction requirement is made FINAL.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joshi (US Patent Number 6,843,723) in view of Brosnan et al. (US Patent Number 6,682,432).

Claim 1: Joshi teaches a system for providing closed-loop operation for promotional events for a video gaming machine (10). The promotional event is associated with particular winning criteria – i.e., as determined by the modified payout structure. (Col 2, 32-39) Joshi describes storing the visual element datasets in a memory device (20) that interfaces with the game machine processor. (Col 2, 40-42) This is combination of memory device and processor is a controller box that is operable to interface to the video gaming machine. There may be a promotional server (152) that is communicatively coupled to the controller box and operable to maintain a database of promotional events with each promotional event having promotional content (visual motif), winning criteria (modified payout structure) and scheduling information (a list of holidays, start and stop

times). (See Summary of the Invention section.) As noted above, this information is loaded into the memory device. Thus the server (152) delivers to the controller box, at least a portion of the database of promotional events. The controller box displays promotional content on the display of the video gaming machine. Figures 12 & 13 show the display of Christmas promotional content. The controller box, which includes the CPU (16), monitors the activity of the video gaming machine to determine if the winning criteria have been met. The controller box provides information indicating that the winning criteria for a particular promotional event have been satisfied – by causing payout mechanism (22) to pay out winnings.

Joshi does not specifically disclose that the promotional server receives from the controller box, messages indicating that the winning criteria for a particular promotional event have been met. It is well known to send all information regarding winnings to a server for casino accounting purposes. Brosnan teaches reporting winning conditions to an accounting server (71). This allows the casino to keep track of the money paid out – a matter of vital importance. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Joshi in view of Brosnan to have the server receive messages from the controller box indicating that the winning criteria for a particular promotional event have been met in order to allow the casino to keep track of money paid out.

Claim 2: The promotional server includes a software program that enables a user to define particular promotional events by defining an award to be associated with the promotional event (i.e., designating the modified payout structure); defining a schedule

for the promotional event; defining the winning criteria for the promotional event; receiving instructions to store the defined promotional event; and storing the defined promotional event into the database. (See Summary of the Invention.)

Claim 3: The software program further comprises an interface to upload graphical and textual content to be included in the promotional content. (Col 10, 14-18)

Claim 4: The software program must include an interface to create graphics and textual content to be included in the promotional content. The data must be created before it can be downloaded.

Claim 5: The controller box is operative to display the promotional content in accordance with the scheduling information. (Fig 18A)

Claim 6: The controller box is operative to receiving entertainment content (i.e., game motifs) from an entertainment source (152) and to display the entertainment content on the display of the video gaming machine.

Claims 7-10: Joshi teaches implementation on both video poker and video blackjack machines. (Col 15, 38) While the choice of which hands to make into winning criteria is a matter of design choice – any combination of cards could be considered a “winning hand”, Joshi teaches that the winning criteria may be the appearance of three symbols that are not included on the payout table. (Col 5, 57-60) Thus Joshi teaches winning combinations that are not in the payout table and teaches winning combinations that are a particular hand. (Figs 4A & B)

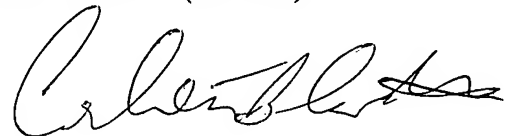
Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Walker et al. teaches a slot machine system that displays premium multimedia entertainment not related to the slot machine game.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, Jessica Harrison can be reached on (571) 272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Corbett B. Coburn
Examiner
Art Unit 3714